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14 UNITED STATES DISTRICT COURT
15
16 NORTHERN DISTRICT OF CALIFORNIA
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18 SAN FRANCISCO DIVISION

17 GOOGLE LLC,
18
19 Plaintiff,
20
21 vs.
22 SONOS, INC.,
23 Defendant.

Case No. 3:20-cv-06754-WHA
Related to Case No. 3:21-cv-07559-WHA

**GOOGLE LLC'S MOTION *IN LIMINE*
NO. 3 TO EXCLUDE PORTIONS OF
THE EXPERT REPORT AND CERTAIN
TESTIMONY OF MR. JAMES
MALACKOWSKI AND DR. KEVIN
ALMEROTH REGARDING GOOGLE'S
NON-INFRINGEMENT ALTERNATIVES**

23 Date: May 3, 2023
24 Time: 12:00 p.m.
25 Location: Courtroom 12, 9th Floor
26 Judge: Hon. William Alsup

1 This motion *in limine* addresses aspects of Mr. James Malackowski's damages opinions
 2 regarding Google's non-infringing alternatives for U.S. Patent Nos. 10,848,885 (the "'885 patent")
 3 and 10,469,966 (the "'966 patent"), as well as Dr. Kevin Almeroth's opinion to the extent Mr.
 4 Malackowski relies on it.

5 **I. INTRODUCTION**

6 Dr. Almeroth's and Mr. Malackowski's opinions that Google's non-infringing alternatives
 7 are not viable because they infringe other unasserted Sonos patents should be excluded under FRE
 8 402 and 403 because neither expert has even identified any such patents, much less conducted an
 9 infringement analysis.

10 **II. STATEMENT OF THE ISSUES TO BE DECIDED**

11 Should Dr. Almeroth's and Mr. Malackowski's opinions regarding the viability of Google's
 12 non-infringing alternatives for the '885 and '966 patents be excluded under FRE 402 and 403?

13 **III. STATEMENT OF RELEVANT FACTS**

14 Dr. Almeroth opines that Google's non-infringing alternatives for the '885 and '966
 15 patents—specifically, the “no standalone mode,” “no overlapping groups” and no “common theme”
 16 alternatives—are not viable because “Sonos has many other patents directed to technology for
 17 grouping ‘zone players’ together for synchronous playback.” Ex. 1 (Alm. Rep.) ¶¶ 766, 777; Ex. 2
 18 (Alm Reply) ¶ 277 at 106. Mr. Malackowski relies on Dr. Almeroth's opinion to rebut the cost
 19 approach that Google's expert utilizes to calculate damages for the '885 and '966 patents. Ex. 3
 20 (Mal Rep.) at 129-130. However, neither Mr. Malackowski nor Dr. Almeroth identify these patents
 21 or provide any supporting infringement analysis.

22 **IV. LEGAL STANDARD**

23 An expert may offer opinions at trial only if “(1) [his] scientific, technical, or other
 24 specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in
 25 issue; (2) the testimony is based on sufficient facts or data; (3) the testimony is the product of reliable
 26 principles and methods; and (4) [he] has reliably applied the principles and methods to the facts of
 27 the case.” FRE 702. The party seeking to admit expert testimony bears the burden of proving its
 28 admissibility. *Lust By & Through Lust v. Merrell Dow Pharm., Inc.*, 89 F.3d 594, 598 (9th Cir.

1996). To be admissible, opinions regarding a reasonable royalty rate must “carefully tie proof of damages to the claimed invention’s footprint in the market place.” *Uniloc*, 632 F.3d at 1317.

3 **V. ARGUMENT**

4 Dr. Almeroth’s opinion that Google’s non-infringing alternatives are not viable because they
5 may infringe other unidentified and unasserted Sonos patents should be excluded under FRE 402
6 and 403. *See* Ex. 1 (Almeroth Rep.) ¶¶ 93, 766, 777. Mr. Malackowski’s reliance on Dr. Almeroth’s
7 opinions should be excluded as well. Ex. 3 (Mal. Rep.) at 129-130.

8 A case from this district is directly on point. In *MEMC Elec. Materials v. Mitsubishi*
9 *Materials Silicon Corp.*, 2004 WL 5363616, at *3 (N.D. Cal. Mar. 2, 2004), the court refused to let
10 plaintiff introduce an unasserted patent to rebut defendant’s non-infringing alternatives under FRE
11 402, particularly since plaintiff never sought to amend its complaint to assert the patent, never
12 exchanged claim charts alleging infringement of the patent, and the court had not construed the
13 claims of the patent. The court held that evidence regarding the unasserted patent was irrelevant,
14 and that if it were to permit such evidence the court “would essentially be forced to conduct a trial
15 within a trial in order to properly adjudicate these new allegations of infringement.” *Id.* In fact,
16 Sonos’s position is even weaker than the patentee’s in *MEMC* because there the patentee identified
17 a specific patent it claimed defendant’s non-infringing alternative infringed. Here, Sonos has not
18 identified any such patent. Ex. _1 (Alm. Rep.) ¶¶ 766, 777; Ex. 2 (Alm. Reply) ¶ 277.

19 Dr. Almeroth’s and Mr. Malackowski’s opinions should likewise be excluded under FRE
20 403 because allowing Sonos’s experts to testify that Google infringes unidentified and unasserted
21 Sonos patents would unfairly prejudice Google, confuse the issues, mislead the jury and waste time.
22 Considering similar facts, cases have excluded similar testimony on FRE 403 grounds. *Cutsforth,*
23 *Inc. v. Westinghouse Air Brake Techs. Corp.*, 2022 WL 228278, at *1 (W.D. Pa. Jan. 26, 2022)
24 (excluding similar testimony under FRE 403 because it would require a “separate proceeding on the
25 merits...to determine whether a non-accused product infringes the non-asserted patents.”); *ViaSat,*
26 *Inc. v. Space Sys./Loral, Inc.*, 2014 WL 11813868, at *1 (S.D. Cal. Feb. 21, 2014) (excluding similar
27 testimony under FRE 403 because the unasserted patents “have not been subject to claim
28 construction, and SS/L has not had an opportunity to challenge their validity”).

1 **VI. CONCLUSION**

2 For the foregoing reasons, Google respectfully requests that the Court exclude any opinions
3 or testimony from Sonos's experts Mr. Malackowski and Dr. Almeroth that Google's non-infringing
4 alternatives for the '885 and '966 patents are not viable because they infringe other unasserted Sonos
5 patents, as described herein.

6
7 DATED: April 13, 2023

QUINN EMANUEL URQUHART & SULLIVAN,
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8
9 By /s/ Sean Pak

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CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule 5-1, I hereby certify that, on April 13, 2023, all counsel of record who have appeared in this case are being served with a copy of the foregoing via email.

/s/ Sean Pak
Sean Pak